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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,718	04/04/2001	Yoji Furuya	36409-01100	3164

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Milbank, Tweed, Hadley & McCloy LLP  
1 Chase Manhattan Plaza  
New York, NY 10005

EXAMINER

POND, ROBERT M

ART UNIT PAPER NUMBER

3625

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/825,718

Applicant(s)

FURUYA, YOJI

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. The abstract of the disclosure is objected to because it is written as two paragraphs. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1, 2, 5-12, 15, 18-22, and 25-30 are rejected under 35 USC 102(e) as being anticipated by Chihara et al. (patent number 6,208,428, hereinafter referred to as "Chihara")**

Chihara teaches all the limitations of Claims 1, 2, 5-12, 15, 18-22, and 25-30. For example, Chihara discloses a system for outputting data selected by user side to an information processing device on a supplier side. Chihara further discloses:

- Output device including data request means: a printer (see at least Fig. 1 (7); Fig. 2 (16); Fig. 7 (2); col. 1, lines 9-57; col. 5, lines 52-67).
- Information processing device (supplier side): a server computer (see at least col. 5, lines 52-67).
  - i. Determination means: inherent in Chihara is determination means of the type of output device connected.
  - ii. Controller for controlling transmission of data to output device: (see at least Fig. 1 (70); Fig. 2 (1); col. 1, lines 24-26).
- Information processing device (user side): producer client computer (col. 5, lines 52-67).
- Output device communications: output device connects to supplier-side information processor independent of user-side information processor (see at least Fig. 7 (2); col. 11, lines 20-26).
- Output device transmission means for sending charge information: transmits charging information; charging information storage means (see at least title; Fig. 1 (76); col. 1, lines 14-57; col. 2, lines 23-36).

- Information processing device recognized the output device: store data of the status and construction of the printer (see at least col. 5, lines 30-31, 60-61).
- Predetermined functionality: printing with charge control program as noted above.
- Identifiers: identifies each producer; means for recognizing every producer (see at least col. 1, lines 62-63; col. 2, lines 14-15).
- Storage means: (see at least Fig. 1 (75, 76); Fig. 2 (14, 18 21, 22)).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 4. Claims 3, 4, 13, 14, 16, 17, 23, and 24 are rejected under 35 USC 103(a) as being unpatentable over Chihara (patent number 6,208,428), further in view of Rager et al. (patent number 5,363,447, hereinafter referred to as "Rager").**

Chihara teaches all the above as noted under the 102(e) rejection and teaches a) storing charging information in memory, b) storing print data, and c) deleting information, but does not disclose deleting information upon detecting a

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power-off condition. Rager teaches erasing memory to maintain data security in the event that a device is tampered with or powered down (see at least col. 1, lines 64-67; col. 4, lines 37-49). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the Chihara to include power-off detection and data deletion as taught by Rager, in order to provide tamper-proof data protection of chargeable print data, and thereby attract data suppliers to the service.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 5,745,883 (Krist et al.) 28 April 1998; teaches billing system for use with document processing system.
- US 5,875,110 (Jacobs) 23 February 1999; teaches vending products using a host side printer or customer side printer.
- US 6,516,358 (Carau, Sr. et al.) 04 February 2003 ; teaches appliance communication manager.
- Asia Computer Weekly; "Internet Printing Gets to 'Just a Mouse Click Away'," 08 June 1998, Proquest #30476127; teaches Internet printing for home shoppers or B2B commerce.
- Business Wire; "HP: The Global Force in Internet Imaging and Printing Solutions Demonstrates New Online Business Methods," 02 March 1999, Proquest #39390782; teaches web printing.
- Machine Design; "Send Print Jobs to Almost Any Printer on the Internet," 11 February 1999, v71n3pg154, 2pgs, Proquest #38815431; teaches Internet printing software.
- Schwartz, Ephraim; "Internet Printing Awaits Standard," InfoWorld, 29 March 1999, v21n13pg18, 2pgs, Proquest #40161977; teaches the Printer Working Group, Internet Printing Protocol, and security aspects with Internet printing.

- Williams, Dennis; "JetDirect Brings Printing to the Net," InfoWorld, 28 December 1998, v20n52/1pg37b, 3pgs, Proquest #37758443; teaches setting up and managing Internet printing.
- PR Newswire; "GENICOM Announces Advance Intelliprint® Controller Architecture," 09 November 1998, 3pgs, Proquest #35781095; teaches Internet printing and printer management tools.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

703-872-9306 (Official communications; including After Final communications labeled "Box AF")



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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

A handwritten signature in black ink, appearing to read 'Robert M. Pond', is written over the printed name.

Robert M. Pond  
Patent Examiner  
May 3, 2004